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OFFICE OF PETITIONS

In re Application of :
Marshall C. Ryan :
Application No. 10/524086 :
Filing or 371(c) Date: 02/09/2005 : ON PETITION
Attorney Docket Number: 30,178-00 :

This is a decision on the Petition for Revival of Application for patent Abandoned Unavoidably, filed August 13, 2008.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

On filing, the inventors named in the present application were Jay D. Nord and Jeffrey K. Drogue. On May 19, 2006, Applicant filed a Correction of Inventorship to add Marshall C. Ryan as an inventor of the present application. The Correction of Inventorship included an oath/declaration executed by inventor Marshall; however, the oath/declaration did not include the residence and/or Post Office address of inventor Marshall.

On February 21, 2007, Applicant filed a Request to Delete as inventors of the present application Jay D. Nord and Jeffrey K. Drogue.

On April 10, 2007, this Office mailed a Notice of Allowance and Issue Fee Due and Notice of Allowability. The Notice of Allowability noted therein the correction of the inventorship by deleting as inventors Jay D. Nord and Jeffrey K. Drogue. Applicant submitted the issue fee on July 9, 2007.

The Office then mailed a Supplemental Notice of Allowability on November 15, 2007, and on January 4, 2008, the Office mailed an Office communication, requiring a Substitute Oath/Declaration executed by Marshall C. Ryan. The Office communication maintained as a reply period that set forth in the Notice of Allowability. A Notice of Abandonment was mailed on April 23, 2008 indicating as the reason for abandonment Applicant's failure to file a proper reply to the Office communication mailed January 4, 2008.

The present petition

Applicant files the present petition and states that in telephone conversations with the Examiner on or about December 27, 2007, and concerning the delay in issuing the patent, Applicant understood that the mailing address of inventor Ryan was required. Applicant filed an Application Data Sheet ("ADS") on December 27, 2008. Applicant provides that after receiving the January 4, 2008 Office communication requiring a Substitute Oath/Declaration, Applicant contacted the Examiner and was told that in view of the ADS, in combination with the Declaration of inventor Ryan filed May 19, 2006, a response to the January 4 Office communication would not be required. Based upon the representations of the Examiner, Applicant believed that a response to the January 4, Office communication would not be required.

Applicant states in the petition that despite the foregoing, and in response to the January 4 Office action, a substitute Declaration signed by Marshall C. Ryan is filed herewith.

A Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (**2**) the petition fee as set forth in 37 CFR 1.17(l); (**3**) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (**4**) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks item (**3**) as set forth above.

Applicable Law, Rules and MPEP

As to item (**3**), Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a

grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard.

> The word unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath , 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff 'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The MPEP 711.03(c) discusses the situation where an Applcant fails to file a reply to an Office action because the Applciant is awaiting a response from this Office. The following example is provided:

> For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay. See Krahn, 15 USPQ2d at 1825. Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985). (Emphasis supplied).

Analysis

Applicant avers that the delay in filing a reply to the Office communication was unavoidable because Applicant reasonably believed, based upon oral representations by the Examiner, that a response to the January 4, Office communication would not be required. Applicant 1) relied upon oral advice from an Office employee, and (2) permitted the reply period to expire while awaiting action from this Office. As states above, the delay is not unavoidable under such circumstances.

Applicant is also reminded of 37 CFR§ 1.2, Business to be transacted in writing, which states

> All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Applicant here asserts that the delay in responding to the Office action was unavoidable because the Examiner did not timely receive the Declaration; Applicant's belief that the

Conclusion

Applicant has failed to demonstrate that the failure to timely and properly reply to the Office action was unavoidable.

Alternate venue

Applicant is urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

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Attn: Office of Petitions

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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
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